REMARKS/ARGUMENTS

Claims 1, 2, 4, 5, 8, 9, 11, 12, 15, 21, 23, 25-30, 32, and 33 are pending. No claims have been amended, added, or canceled. In view of the following arguments, withdrawal of the finality of the November 15, 2004 Office Action is respectfully requested.

The MPEP §706.07(a) indicates that "[a] second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element." In this case, it is respectfully submitted that finality of the November 15, 2005 Action ("present Action") on the merits is premature because it includes rejections, on prior art not of record (the first prong), of claims amended to include limitations which should reasonably have been expected to be claimed in view of the previous Actions 35 USC §112, second paragraph rejections (the second prong).

More particularly, the present Action rejects claims 1, 2, 4, 5, 8, 9, 11, 12, 15, 21, 23, 25-30, 32, and 33 under 35 USC §103(a) in view of Hollingsworth et al., "Binary Version Management for Computational Grids." Hollingsworth et al. is "prior art not of record." Rejecting claimed subject matter in view of prior art not previously of record meets the first prong of the two part test for identifying a premature final Office Action. The present Action concludes that "Applicant's amendments necessitated the new ground(s) of rejection." This conclusion is unsupportable. The amendments made to the claims "should reasonably have

been expected to be claimed" in view of the previous Action's outstanding 35 USC §112, second paragraph rejections.

Specifically, the March 15, 2004 Office Action (the "previous Action") asserted that claims 1, 8, 15, 21, and 29 stood rejected under 35 USC §112, second paragraph as being indefinite. In addressing these claims, the previous Action asserts "[w]ith regard to claims 1, the claimed subject matter "using the processed image", in lines 12-13, renders the claim indefinite because it is unclear whether the clause "using the processed image" is describing "the processed image" or "deriving a unique identifier." Claims 8, 15, 21, and 29 were similarly rejected. To address these rejections, the July 15, 2004 Response to the previous Action amended claims 1, 8, 15, and 21.

For example, **claim 1** was amended as follows:

"A software version control method comprising:

assigning each of a plurality of data files to one of a plurality of specific corresponding downloadable file groups;

generating processed images and a listing of unique identifiers as follows:

for each downloadable file ~~group,~~ group:

compressing together ~~all assigned~~ data files assigned to the downloadable file group to form one processed image of the processed images ~~for the downloadable file group~~; and

deriving a unique identifier of the unique identifiers for the one processed image, the unique identifier being derived as a function of a portion of ~~using~~ the one processed image;

~~generating a listing of unique identifiers;~~

storing the processed images and the listing of unique identifiers to ~~within~~ a source device;

comparing the listing of unique identifiers with a current listing of unique identifiers ~~of~~ in a client device; and

selectively sending processed images from the source device whose unique identifiers appear in the listing of unique identifiers but not in the current listing of unique identifiers in the client device."

These amendments to claim 1 "should reasonably have been expected to be claimed" in view of the previous Action's 35 USC §112, second paragraph rejection. The July 15, 2004 Response even clearly states that "[c]laims 1, 8, 15, and 21 have been amended to more particularly point out the subject matter of the invention. These amendments address these 35 USC §112, second paragraph rejections." Clearly, these claim amendments address the Action's concern that "[w]ith regard to claims 1, the claimed subject matter "using the processed image", in lines 12-13, renders the claim indefinite because it is unclear whether the clause "using the processed image" is describing "the processed image" or "deriving a unique identifier." For this reason alone, the amendments to claim 1 "should reasonably have been expected to be claimed" in view of the previous Action's 35 USC §112, second paragraph rejection.

In view of the above, the finality of the present Action is premature because it includes a rejection, on prior art not of record (Hollingsworth et al.), of claims amended to include limitations which should reasonably have been expected to be claimed in view of the 35 USC §112, second paragraph rejections that were outstanding at that time. The MPEP §707(d) indicates "[i]f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection." Applicant hereby makes such a request for withdrawal of finality of the present Action.

Additionally, **claims 8, 15, 21, and 29** were amended in the July 15, 2004 Response to the previous Action. For the reasons already discussed above with respect to claim 1, the amendments to these claims "should reasonably have been

expected to be claimed" in view of the previous Action's 35 USC §112, second paragraph rejection of these claims. For these additional reasons, the finality of the present Action is premature, and withdrawal of the finality of the present Action is respectfully requested.

Conclusion

Withdrawal of the finality of the November 15, 2004 Office Action is respectfully requested.

Respectfully Submitted,

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